## REMARKS

A Petition for Extension of Time is being concurrently filed with this Amendment. Thus, this Amendment is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

***Status of the Claims***

In the present Amendment, claims 10-12 have been added. Also, claim 3 has been previously canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 1, 2 and 4-12 are pending in the present application.

Claims 10-12 are directed to other embodiments of the present invention and have been added for the Examiner's consideration. No new matter has been added by way of these new claims because each new claim is supported by the present specification. For example, new claim 10 has support in the specification at page 42, last paragraph. For claim 11, please refer to 39 of the present specification. Finally, new claim 12 has support in the specification at least at page 43, last paragraph.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

***Issues Under 35 U.S.C. § 103(a)***

Claims 1, 2, 4 and 6-9 stand rejected under 35 U.S.C. § 103(a) as being obvious over Inoue *et al.* '603 (U.S. Patent No. 4,978,603) in view of Saito '713 (U.S. Patent No. 6,645,713; newly cited) (see paragraphs 1-2 of the Office Action).

Also, claim 5 stands rejected under 35 U.S.C. § 103(a) as being obvious over Inoue *et al.* '603 in view of Saito '713 and Ichikawa *et al.* '159 (U.S. Patent No. 5,270,159) (see paragraph 3 of the Office Action).

Applicants respectfully traverse both rejections, and reconsideration and withdrawal of these rejections are respectfully requested. Overall, Applicants do not concede that a *prima facie* case of obviousness has been established with respect to either rejection.

The present invention is, in part, directed to "fine grains [that] are prepared via at least one Ostwald ripening step, and wherein the silver halide fine grains are continuously prepared using a device substantially free of residence portion". Thus, the presently claimed process includes an Ostwald ripening step that is substantially free of a residence portion. However, the cited combination of references fails to disclose the instantly claimed Ostwald ripening step.

In the outstanding Office Action, the Examiner states that Inoue '603 "fails to specifically teach the type of apparatus/grain formation process employed in the method for preparing the above cited grains" (see the last sentence of page 2 of the Office Action). Also, Saito '713 is cited as disclosing "a method of preparing silver halide grains in which the grains are formed employing an apparatus substantially free of a residence portion . . ." (see the Office Action at page 3, first paragraph). Accordingly, the secondary references of Saito '713 (for claims 1, 2, 4

and 6-9) and Ichikawa '159 (for claim 5) are cited to account for the deficiencies of Inoue '603. However, Applicants respectfully submit that each of Saito '713 as well as Ichikawa '159 fails to properly account for the deficiencies of the primary reference of Inoue '603.

In citing Saito '713 in the Office Action, the Examiner does not appear to refer to any particular parts of the secondary reference. Applicants have reviewed the cited secondary references, especially Saito '713, and respectfully submit that none of the cited references disclose an Ostwald ripening step as instantly claimed. In particular, none of the cited references discloses a device that conducts the Ostwald ripening step that is substantially free of a residence portion. The Saito '713 reference appears to disclose that a portion where material solutions are mixed to form fine particles is free of "residence portion." However, Saito '713 does not have any disclosure regarding a ripening step. Thus, Applicants respectfully disagree as to what Saito '713 discloses. In addition, each of Inoue '603 and Ichikawa '159 does not disclose the instantly claimed Ostwald ripening step that is substantially free of residence portion. Thus, none of the references, even in combination, discloses all instantly claimed features.

The rejection of at least pending claim 1 is improper in that there is no disclosure of all claimed features in the combination of Inoue '603 plus Saito '713. Applicants respectfully add that none of the cited references, even in combination, discloses a process for the preparation of tabular grains of the invention of pending claim 7 of the present invention or the ripening unit that is free of a residence portion as recited in pending claim 11. Therefore, even when the cited references are combined, each of such combinations fails to disclose all instantly claimed features and a *prima facie* case of obviousness has not been established for either rejection. This

is because U.S. case law holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Here, there is no disclosure of all claimed features regarding either outstanding rejection. Thus, under *In re Vaeck*, these rejections have been overcome.

Regarding the requisite motivation, Applicants note that it is not *prima facie* obvious to modify a reference unless the references suggest an advantage to be gained from the modification. *See In re Sernaker*, 217 USPQ 1, 6 (Fed. Cir. 1983). Here, no such advantage in using the claimed Ostwald ripening step is disclosed in the cited Inoue '603, Saito '713 and Ichikawa '159 references. Thus, the requisite motivation is lacking for both of the cited combinations of references.

Reconsideration and withdrawal of these rejections are respectfully requested.

***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present

application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By _____

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